IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	:	Susanne Emig et al.	Confirmation No.: 2756
Serial No.	:	10/555,040	
Filed	:	November 21, 2005	
TC/A.U.	:	1615	
Examiner	:	C. E. Helm	
Docket No.	:	05-549-CIP	
Customer No.	:	34704	

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313

APPEAL BRIEF

Sir:

This brief is submitted in support of the Notice of Appeal filed April 21, 2011. The brief is accompanied by authorization to charge a deposit account for the requisite filing fee.

(i) Real Party in Interest

The real party in interest in this appeal is Schwan-STABILO Cosmetics GmbH & Co. KG, which is also the assignee of record of the application.

(ii) Related appeals and interferences

There are no known related appeals or interferences.

(iii) Status of Claims

The status of claims is as follows:

Claims 44-50, 58-66, 76, 78-86 and 90-91 are rejected. Claims 1-43, and claims 88-89 have been canceled. Claims 51-57, 67-75, 77, 87 and 92 have been withdrawn from consideration.

(iv) Status of Amendments

Applicant's amendment filed June 21, 2011 has been entered for purposes of appeal as per Applicant's telephone discussion with SPE Robert Wax.

A listing of the claims on appeal are attached hereto in the claims appendixed to this brief.

(v) Summary of claimed subject matter

Independent claim 44 will be referenced with respect to the substitute specification filed by Applicant on October 27, 2005.

Independent claim 44 calls for a cosmetic preparation (paragraph [0002]) wherein the preparation is suitable in the area of decorative cosmetics for caring for, coloring and improving skin, lips and eyelids (paragraph [0019]), the cosmetic preparation being in the form of an emulsion (paragraph [0023]). The emulsion comprises a lipophilic outer phase and a hydrophilic inner phase (paragraph [0023]). The outer phase contains at least one polyvalent ester component (paragraph [0023], lines 5-7). The outer phase further contains at least one volatile silicone. The inner phase contains an aqueous medium and hydrophilic additives (paragraph [0023], lines 2-6). The preparation further includes at least one emulsifier and a solids phase (paragraph [0023], lines 7-9 and paragraph [0039]). In accordance with the present invention the polyvalent ester is selected from the group consisting of (1) polyvalent, at least divalent alcohols each with at least two acid residues, (2) polyvalent, at least divalent acids and at least two respective alcohol residues, and (3) polyvalent alcohols and polyvalent acids, wherein the chain length of the residues originating from the alcohol is C_2 to C_{60} and the chain length of the residues originating from acids is C_4 to C_{60}, wherein the ester has a melting point in the range of 40 to 200°C (see paragraph [0026] and paragraph [0027]). The cosmetic preparation is selected from the group consisting of lip rouge, blusher, makeup, eyeshadow, camouflage and a concealer (paragraph [0019]).

(vi) Grounds of rejection to be reviewed on appeal

1. Claims 44-50, 58-61, 64-66, 76, 78-80, 86, 90 and 91 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Roulier et al. in view of Omura et al., Krzysik et al. and Abil© EM 90.
2. Claims 44, 61, and 63 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Roulier et al. in view of Omura et al., Krzysik et al. and Abil© EM 90 in further view of Stepniewski et al.
3. Claims 44, 76, and 81-83 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Roulier et al. in view of Omura et al., Krzysik et al. and Abil© EM 90 in further view of Katsuyama et al.
4. Claims 44, 76, 81, and 84-85 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Roulier et al. in view of Omura et al., Krzysik et al., Katsuyama et al. and Abil© EM 90 in further view of Wendel et al.

(vii) Argument

It is submitted that claim 44 clearly defines over the cited and applied prior art references for the reasons set forth hereinbelow.

In reaching a conclusion of obviousness, the Examiner has set forth the following:

> " 'It is *prima facie* obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose....[T]he idea of combining them flows logically from their having been individually taught in the prior art.' *In re Kerkhoven*, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980) see MPEP 2144.06. Therefore since zinc oxide nanopigment, 3-(4-methylbenzydiene) camphor, and isoamyl p-methoxycinnamate are all known as UV filters, it would have been obvious to one of ordinary skill at the time of the invention include all three of them as the sunscreen agents in the composition of Roulier et al. in view of Omura et al., Krzysik et al. and Katsuyama et al. as evidenced by the Abil© EM 90 reference."

By the Examiner's own standard, the rejection must fail as, by the Examiner's own standard, the compositions attempted to be combined are not useful for the same purpose and when formed do not correspond to the composition of the instant application.

With respect to independent claim 44, independent claim 44 sets forth the following:

> ...wherein the outer phase comprises at least one polyvalent ester....
> wherein the polyvalent ester is selected from the group consisting of
> (1) polyvalent, at least divalent alcohols each with at least two acid residues,
> (2) polyvalent, at least divalent acids and at least two respective alcohol residues, and
> (3) polyvalent alcohols and polyvalent

acids,

wherein the chain length of the residues originating from the alcohol is C_2 to C_{60} and the chain length of the residues originating from the acids is C_4 to C_{60}, wherein the ester has a melting point in the range of 40 to 200°C.

According to the Examiner's statement (starting on page 4, last line), the waxes taught by Roulier are envisioned as fatty esters that are solid at 25°C and more particularly having a melting temperature above 65°C. There is no teaching about polyvalent esters in the Roulier reference.

According to the Examiner's statement, Roulier teaches sun screen agents in column 4, lines 17-26. Applicant cannot find the wording sunscreen in the cited chapter.

According to the Examiner's statement, Krzysik teaches a set of fatty esters with a melting point above 35°C that are suitable for use in cosmetic compositions intended to protect or repair skin as well as cosmetic applications (see Column 4, lines 5-9 and 14-17). There is no teaching "as cosmetic application" beside "cosmetic cleansing". In view of Applicant's description there is no hint for cleansing products.

According to the Examiner's statement Krzysik teaches "One of these fatty esters that also has the preferred melting point of Roulier is pentaerythritol tetrabehenate (see Column 5, lines 45-46 and 65-66, Column 6, line 16). The teaching of the cited paragraphs is: "The composition ... include ... solidifying agents." and "Examples of suitable agents include...the following compounds:...pentaerythrityl tetrabehenate". There is no teaching about the use of fatty esters. Furthermore, there is a teaching to elect a solidifying agent from: "alkyl silicones (silicon),...polypropylene (polymer), zinc stearate (soap) and mixtures of such compounds.

Roulier is directed to a "W/O-Emulsion".

Krzysik is directed to an "Absorbent Article" according to title, abstract and claims.

Keeping in mind the definition for "obvious" as the Examiner stated, these documents are not useful for the same purpose. Thus, the combination is not obvious.

There is no teaching in Roulier to use polyvalent esters.

There is no teaching in Kryzik to use polyvalent esters for cosmetic use in general.

It is submitted that claim 44 clearly defines over the prior art for the reasons set forth in Applicant's last filed amendment. The Examiner appears confused with part of the argument previously presented. The Examiner on page 10, first full sentence of the final rejection, sets forth the following:

> "...In the case of the teaching of fatty acid esters with a melting point above 35°C by Krzysik et al., the referenced citation is found at column 5 lines 64-65. These citations have been corrected accordingly in the rejection. Even in the absence of the provided specific citations, both Rouler et al. and Krzysik et al. contained the teachings as discussed in the rejection."

It appears that the Examiner has missed the point raised in Applicant's previous arguments for patentability. The point is the Krzysik et al. reference does not deal with a cosmetic preparation. The Krzysik et al. reference deals with an absorbent article. This is clear from a reading of the Krzysik et al. reference. Thus, the Examiner's statement that the Krzysik et al. reference teaches a set of fatty esters with a melting point above 35°C particularly suitable for use in cosmetic compositions is totally without merit. The Krzysik et al. reference does not deal with cosmetic compositions but rather with an absorbent article.

In addition to the foregoing, it is submitted that the Examiner's rejection is untenable for the following reasons.

According to the Examiner's statement, Krzysik teaches a set of fatty esters with a melting point above 35°C that are suitable for use in cosmetic compositions intended to protect or repair skin as well as cosmetic applications (see Column 4, lines 5-9 and 14-17). Krzysik et al. does not deal with a cosmetic composition. Therefore, Krzysik et al. is not analogous art and not appropriate for combination with the primary reference. The Krzysik et al. reference deals with an absorbent article and not a cosmetic composition. Applicant's claims and disclosure do not deal with a cleansing product and therefore the application of the Krzysik et al. reference by the Examiner in rejecting the claims of the instant application amounts to hindsight reconstruction with no modification in the references nor connection to the process disclosed therein.

According to the Examiner's statement Krzysik teaches "One of these fatty esters that also has the preferred melting point of Roulier is pentaerythritol tetrabehenate (see Column 5, lines 45-46 and 65-66, Column 6, line 16). The teaching of the cited paragraphs is: "The composition ... include ... solidifying agents." and "Examples of suitable agents include...the following compounds:...pentaerythrityl tetrabehenate". There is no teaching about the use of fatty esters. Furthermore, there is a teaching to elect a solidifying agent from: "alkyl silicones (silicon),...polypropylene (polymer), zinc stearate (soap) and mixtures of such compounds.

Roulier is directed to a "W/O-Emulsion".

Krzysik is directed to an "Absorbent Article" according to title, abstract and claims.

Keeping in mind the definition for "obvious" as the

Examiner stated, these documents are not useful for the same purpose. Thus, the combination is not obvious.

There is no teaching in Roulier to use polyvalent esters.

There is no teaching in Kryzik to use polyvalent esters for cosmetic use in general.

In light of the foregoing, it is submitted that independent claim 44 clearly defines over the cited prior art references and the Examiner's rejection of same should be withdrawn.

With regard to the grounds of rejection set forth in paragraph (vi)(2) above, Applicant again traverses the Examiner's rejection. Applicant does not claim to be the first to use a non-volatile silicone oil in a cosmetic preparation; however, the combination of elements set forth in dependent claims 61 and 63 result in benefits which are not appreciated in the prior art. The prior art cited by the Examiner does not teach that the non-volatile silicone oils claimed in combination with the volatile silicone oils and other components allow for the solid phases to be integrally incorporated into a stable preparation. In this regard, see paragraphs [0039] and [0040].

The grounds of rejection set forth in paragraph (vi)(3) set forth above, is further defective. It is not seen that there is an adequate teaching of the nanopigment material claimed in combination with the other elements.

Finally, the Examiner's rejection as set forth in paragraph (vi)(4) above is likewise fatally defective as the nanopigment combined with the light filtering substances is taught only by Applicant's instant disclosure.

In summary, the Examiner has combined four separate and distinct prior art references in rejecting independent claim 44. The Examiner asserts that she has established a *prima facie* case of obviousness, it is respectfully submitted that Applicant's

arguments presented above with regard to the rejection of claim 44 clearly demonstrates that the Examiner's *prima facie* case of obviousness is without merit and that the combination of references proposed by the Examiner amounts to nothing more than a hindsight reconstruction based on Applicant's instant disclosure. Accordingly, it is earnestly submitted that the Examiner's rejection is untenable and should be reversed by the Honorable Board of Appeals.

This paper is submitted responsive to the Notice of Appeal filed on April 21, 2011. An authorization to charge a Deposit Account for this matter accompanies this paper. It is believed that no additional fee is due. If any such fee is due, please charge same to Deposit Account No. 02-0184.

Respectfully submitted,

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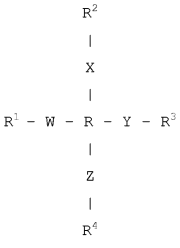
Date: June 21, 2011

(viii) Claims Appendix

44. A cosmetic preparation suitable in the area of decorative cosmetics, the cosmetic preparation comprises an emulsion comprising a lipophilic outer phase and a hydrophilic inner phase, wherein the outer phase comprises at least one polyvalent ester, at least one volatile silicone and optionally further lipophilic additives, and the inner phase contains an aqueous medium and optionally hydrophilic additives, wherein the preparation further includes at least one emulsifier and a solids phase, wherein the polyvalent ester is selected from the group consisting of (1) polyvalent, at least divalent alcohols each with at least two acid residues, (2) polyvalent, at least divalent acids and at least two respective alcohol residues, and (3) polyvalent alcohols and polyvalent acids, wherein the chain length of the residues originating from the alcohol is C_2 to C_{60} and the chain length of the residues originating from acids is C_4 to C_{60}, wherein the ester has a melting point in the range of 40 to 200°C, wherein the cosmetic preparation is selected from the group consisting of lip rouge, blusher, makeup, eyeshadow, camouflage and a concealer.

45. A preparation, in particular a cosmetic preparation according to claim 44, wherein the polyvalent ester has further functional groups selected from the group consisting of hydroxyl, carboxyl, amino, acid amide, ester groups and mixtures thereof.

46. A preparation according to claim 44, wherein the polyvalent ester component contains a compound formula I:



wherein R is a linear, branched or cyclic hydrocarbon residue with 1 to 8 carbon atoms, W, X, Y, Z are each independently of each other -C(O)O-, -OC(O)-, -O-, $-NR^5_2$ or -NC(O)- and each of the residues R^1, R^2, R^3, R^4 and R^5 respectively independently denotes a linear or branched, long-chain hydrocarbon residue.

47. A preparation according to claim 46, wherein the polyvalent ester is a compound of formula I, wherein W, X, Y and Z each signify an ester group, R signifies C and at least three of the residues R^1, R^2, R^3 and R^4 respectively independently signify a C_6 to C_{24} alkyl residue and the fourth of the residues signifies H or a C_6 to C_{24} alkyl residue.

48. A preparation according to claim 44, wherein in the ester component the sum of the carbon atoms of alcohol and carboxylic acid residues is in a range of 35 to 150.

49. A preparation according to claim 44, wherein the polyvalent ester is a pentaerythritol ester.

50. A preparation according to claim 49, wherein the pentaerythritol ester is selected from the group consisting of pentaerythrityl tetramyristate, tristearate, tetrastearate, triisostearate, tetraisostearate, tribehenate, tetrabehenate, tetra-(ethylhexyl-dodecanoate), tri-(12-hydroxy)-stearate, tetra-(12-hydroxy)-stearate, trierucate, tetraerucate, tetramelissinate and mixtures thereof.

58. A preparation according to claim 44, wherein the polyvalent ester is contained in a range of between 0.5 and 20 percent by weight.

59. A preparation according to claim 44, wherein the polyvalent ester is contained in a range of between 2 and 12 percent by weight.

60. A preparation according to claim 44, wherein the volatile silicone oil is selected from the group consisting of hexamethyl cyclotrisiloxane, octamethyl cyclotetrasiloxane, decamethyl cyclopentasiloxane, dodecamethyl cyclohexasiloxane, hexamethyl disiloxane, octamethyl trisiloxane, decamethyl tetrasiloxane, dodecamethyl pentasiloxane and mixtures thereof.

61. A preparation according to claim 44, further including a non-volatile silicone oil in an amount of less than 5 percent by weight.

62. A preparation according to claim 44, wherein the silicone oil is a non-volatile silicone oil or mixtures of non-volatile silicone oils.

63. A preparation according to claim 61, wherein the non-volatile silicone oil is selected from the group consisting of dimethyl polysiloxanes with differing chain length and differing

viscosity, and arylated silicone oils selected from the group consisting of phenyldimethicone, phenyltrimethicone, diphenyldimethicone and mixtures thereof.

64. A preparation according to claim 44, wherein the emulsifier is a W/O emulsifier or a mixture of W/O emulsifier and W/S emulsifier.

65. A preparation according to claim 44, wherein the emulsifier is a non-ionogenic W/O emulsifier.

66. A preparation according to claim 65, wherein the non-ionogenic W/O emulsifier is selected from the group consisting of sorbitan sesquioleate, sorbitan laurate, soya sterol, PEG-5 soya sterol, polyglyceryl-4 isostearate, polyglyceryl-2-PEG-4 isostearate, polyglyceryl-2 sesquiisostearate, cetyl-PEG/PPG dimethicone, trioleyl phosphate, trioleth-8-phosphate, trilaureth-4-phosphate and mixtures thereof.

76. A preparation according to claim 44, wherein the solid phase comprises fillers, effect substances, inorganic pigments, organic pigments and mixtures thereof.

78. A preparation according to claim 76, wherein the solid phase is contained in quantitative proportions in a range of 0 to 40 percent by weight.

79. A preparation according to claim 76, wherein the solid phase is contained in quantitative proportions in a range of 5 to 30 percent by weight.

80. A preparation according to claim 76, wherein the solid phase is contained in quantitative proportions in a range of 8 to 20 percent by weight.

81. A preparation according to claim 76, wherein the inorganic pigment is a nanopigment with a particle size of 5 to 50 nm, which is selected from the group consisting of titanium dioxide, zinc oxide, zirconium oxide, cerium oxide, aluminium oxide, silicon dioxide, and mixtures thereof.

82. A preparation according to claim 81, wherein the nanopigment is contained in an amount of 2 to 20 percent by weight.

83. A preparation according to claim 81, wherein the nanopigment is contained in an amount of 5 to 10 percent by weight.

84. A preparation according to claim 81, wherein the nanopigment is combined with oil-soluble UV-A and UV-B light filter substances.

85. A preparation according to claim 84, wherein the oil-soluble UV-A and UV-B light filter substances are 4-methylbenzylidene camphor and isoamyl p-methoxycinnamate.

86. A preparation according to claim 76, wherein the inorganic pigment is selected from the group consisting of titanium dioxide, zinc oxide, iron oxides, chrome oxide, hydrated chrome oxide, ultramarine, Berlin Blue (Ferric Blue), mica, mica coated with titanium dioxide, mica coated with titanium dioxide and metal oxides, bismuth oxide chloride, coated bismuth oxide chloride, metal powder in flake form of aluminium, brass, bronze, copper, silver, gold, and mixtures thereof.

90. A preparation according to claim 44, wherein the cosmetic preparation is an agent for fixing lipstick or lip rouge, a care foundation, a skin care agent or a sun protection agent.

91. A preparation according to claim 44, wherein the preparation

is a workable paste in the form of a water-in-silicone emulsion with a complex viscosity of 800 to 6,000 Pas and a zero viscosity of 200,000 to 1,200,000 Pas, (shearing rate at zero viscosity 0.00005 s^{-1}; temperature 298.15 K).

(ix) Evidence appendix – None

(x) Related proceedings appendix - None